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OFFICE OF PETITIONS

In re Application of	:	
Quintens et al.	:	
Application No. 09/782,835	:	DECISION ON PETITION
Filed: February 14, 2001	:	
Attorney Docket No. 27500/016	:	

This is a decision on the "Petition to Revive Unavoidably Abandoned Application Alternative Petition to Revive Unintentionally Abandoned Application," filed on August 1, 2005.

On June 7, 2004, the Examiner mailed a final Office action, which set a three-month shortened statutory period to reply. On September 2, 2004, petitioner submitted an amendment in response to the Office Action. Thereafter, on October 8, 2004 (certificate of mailing dated October 6, 2004), petitioner filed a notice of appeal and a request for an extension of time for response within the first month, as well as paid the requisite fees. However, petitioner failed to submit an appeal brief (and appeal brief fee) within two months of the date of receipt of the notice of appeal in the USPTO pursuant to 37 CFR 1.192(a). As no claims were allowed, the above-identified application became abandoned December 9, 2004. See MPEP 1206.

On June 23, 2005, petitioner submitted a request for continued examination (RCE) with the appropriate fee. On June 30, 2005, the Examiner mailed an Advisory Action Before the Filing of an Appeal Brief, stating that the amendment filed on September 2, 2004, failed to *prima facie* place the application in condition for allowance. On July 14, 2005, the Office mailed a Notice of Abandonment.¹ On July 22, 2005, the Examiner mailed a Notice of Improper Request for Continued Examination (RCE), indicating that the RCE filed on June 23, 2005, was improper because petitioner did not timely file it. On August 1, 2005, petitioner filed the present petition, a RCE, a preliminary amendment, and an authorization to charge the necessary fees.

¹ The Notice of Abandonment indicated that the application became abandoned for failure to properly reply to the final Office action of June 7, 2004. However, the application became abandoned on December 9, 2004, for failure to file a timely appeal brief.

Petition under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item and (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.² In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538,

213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is “unavoidably” abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm’r Pat. 31 (Comm’r Pat. 1887).

In the present petition, petitioner stated that the delay in filing a timely response “was due to the failure of the Office to indicate the disposition of the previous action.” *Petition of August 1, 2005, p. 3*. Petitioner further explained that petitioner “was not able to ascertain if the previous comments [and] remarks were sufficient to overcome the rejections.” *Id.*

The Office notes that it is incumbent upon an applicant to take steps to ensure against abandonment of an application. The Office reminds petitioner that the above-identified application became abandoned because petitioner failed to submit a timely appeal brief within the period set forth in 37 CFR 1.192(a). In the present case, petitioner did not provide any explanation or documentation demonstrating why he was unavoidably delayed from filing an appeal brief (and appeal brief fee) within two months of the Notice of Appeal filed on October 8, 2004, or obtaining an extension of time.

Rather, petitioner asserted that the delay was unavoidable because the USPTO failed to indicate if his previous comments and remarks were sufficient to overcome the rejections. Assuming, *arguendo*, that the application became abandoned for failure to timely and properly respond to the final Office action, the Office reminds petitioner that abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action, not by the mailing of an Office communication, such as an Advisory Action. MPEP 711.03(c); See Krahm v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm’r Pat. 1984).

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an “unavoidable” delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm’r Pat. 130, 131 (1891).

Thus, the application became abandoned due to petitioner’s failure to submit an appeal brief (and appeal brief fee) prior to the expiration of the time period set forth in 37 CFR 1.192(a) and not because of delay in the mailing the Advisory Action or any other error on the part of the USPTO. Accordingly, the record reveals that petitioner did not take appropriate action to ensure that a proper response was timely filed so as to prevent the application from becoming abandoned.

Petitioner has not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Therefore, the petition under 37 CFR 1.137(a) is **dismissed**.

Petition Under 37 CFR 1.137(b)

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from seeking relief by filing a petition under 37 CFR 1.137(b) on the basis of unintentional delay.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 CFR 1.137(b)(3) requires a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional” be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of a RCE and an amendment and authorized the Office to charge the Deposit Account for the requisite fees. Accordingly, the petition under 37 CFR 1.137(b) is **granted**.

The fees for filing both a petition under 37 CFR 1.137(a) and 1.137(b) will be charged to petitioner’s Deposit Account as authorized. The Office notes that the finance records indicate that the Office charged the fee for filing a RCE to petitioner’s Deposit Account on June 24, 2005, and again on August 1, 2005. Only one RCE filing fee is necessary. Therefore, the additional \$790.00 RCE fee will be refunded to petitioner’s Deposit Account.

This matter is being referred to Technology Center Art Unit 1614.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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